

## Remarks/Arguments

Claims 1, 2, 4, 5, 14-17, and 19-21 are pending. Claims 1 and 4 have been amended herein. Claims 12 and 18 have been canceled. Claims 3, 6-11, and 13 were previously canceled. Applicant has amended claim 1 to incorporate a limitation from claim 12 which specifies that the step of admixing further includes admixing at least one isolated nucleic acid molecule containing insert sequence. Applicant has also amended claim 1 to specify that the claimed method include selecting a hybrid molecule distinguished from other hybrid molecules as being a molecule in which the second vector detection element is not created. Support for the amendment to claim 1 is found in the original claims and in the specification, e.g., at paragraphs [0049] – [0051] (referring to the specification published as US Pat. Pub. No. 2003/0017552). Claim 4 has been amended to be consistent with amended claim 1. No new matter is added by this amendment.

The following remarks are in response to the Office Action mailed October 30, 2008 (“the Office Action”).

### Rejections under 35 U.S.C. §102

Claims 1, 2, 4, 5, 12, and 14-21 have been rejected under 35 U.S.C. §102(e) as being anticipated by Harney et al., US Patent No. 6,495,318 (“Harney”). The Office Action states that Harney discloses a method of preparing a DNA vector by providing at least two collections of nucleic acid molecules that are DNA vector fragments, wherein vector fragments within the collections include portions of a vector element that cannot alone provide vector element function. The Office Action further states that “each of the fragments in Fig. 1 may be considered to comprise a first or second portion of a second vector element, which if nucleic acid is inserted between said first and second portion, would prevent creation of the ‘second vector detection element.’”

The claims are directed to methods of preparing a DNA vector. Although Applicant disagrees that Harney anticipates the claims, solely to advance prosecution, claim 1 has been amended herein to specify that the methods include admixing at least one nucleic acid molecule containing insert sequence and selecting a hybrid molecule distinguished from other hybrid molecules as being a molecule in which the second vector detection element is not created. As

described in the specification, e.g., at paragraph [0049], one may design vector fragments such that if an insert fragment becomes linked between them, a vector detection element is not created. This allows one to distinguish constructs containing an insert from constructs lacking an insert.

Harney does not disclose or suggest a method of preparing a DNA vector in which hybrid molecules are produced, and in which hybrid molecules that contain an insert are distinguished from hybrid molecules that do not contain an insert, based on the non-creation of a vector detection element. The Office Action cited to Figure 1 in Harney which depicts a schematic drawing of a plasmid and various plasmid components. Figure 1 of Harney does *not* depict a *method* as claimed. It certainly does not depict a method that employs DNA vector fragments designed such that a vector detection element is not created when an insert fragment becomes linked between them. A method that employs all of the features recited in Applicants' claims is not disclosed in Harney. In light of the present amendment and arguments, Applicant respectfully requests withdrawal of the rejection of claims 1, 2, 4, 5, 14-17, and 19-21 (claims 12 and 18 have been canceled).

### Conclusion

Applicant submits that the present application is in condition for allowance. A notice to that effect is respectfully requested.

If the Examiner believes a telephone call would be useful in expediting prosecution of this application, the undersigned invites the Examiner to call her at the number below.

Please charge any fees associated with this response, or apply any credits, to our Deposit Account Number 03-1721, referencing attorney docket no. 2003320-0032.

Respectfully submitted,

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